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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,108	05/24/2001	Craig S. Skinner	24530.01800	3048

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John W. Carpenter  
CROSBY, HEAFEY, ROACH & MAY  
P.O. Box 7936  
San Francisco, CA 94120-7936

EXAMINER

SHARMA, SUJATHA R.

ART UNIT	PAPER NUMBER
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2684

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DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/865,108

Applicant(s)

SKINNER ET AL.

Examiner

Sujatha Sharma

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. Claim 11 recites the limitation "RF enabled device" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to a program, which is non-statutory subject matter. See MPEP 2106.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Mauney [US 6,484,027].

Regarding claim 1, Mauney discloses a handset/electronic device with enhanced features and capabilities. Mauney further discloses the device to comprise:

- A radio unit configured to communicate with a network; see col. 13, lines 42-47
- at least one memory device configured to store application and system programs; see col. 13, lines 34-47 and col. 14, lines 1-5
- a processing unit coupled to said radio unit and said at least one memory unit configured to run the application and system programs; see col. 13, lines 34-47
- wherein at least one of the application and system programs include a software enabled switch for enabling and disabling the radio unit; See col. 13, line 34 – col. 14, line 5

Regarding claim 2, Mauney further discloses a method wherein the said application and system programs comprise a notification program configured to notify a user if the radio is disabled upon invoking a program that utilizes the radio. See col. 13, line 57 – col. 14, line 5.

Regarding claim 3, Mauney further discloses a method where the notification program is further configured to give the user the option to either continue executing the application or system program and automatically enable the radio or discontinue execution of the application or system program and leave the radio disabled. See col. 13, line 48 – col. 14, line 5.

Regarding claim 4, Mauney further discloses the electronic device to comprise of a display screen and at least one of said system and application programs configured to generate a graphical user interface on the display screen having at least one soft button programmed to enable and disable said radio device. See Figs 4A, 4B and col. 13, line 54 – col. 14, line 5.

Regarding claim 5, Mauney further discloses a graphical user interface having a first soft button entitled “radio on” and a second soft button labeled “radio off” and an enablement of the radio device is indicated by the corresponding indicators. See col. 13, lines 48-61.

Regarding claim 12, Mauney discloses a method of notifying a user of an RF enablement of a device comprising the steps of:

- identifying the invocation of a mechanism requiring access to the RF capabilities; See col. 13, line 34 – col. 14, line 5
- determining the RF enablement of the RF device; See col. 13, lines 57-61
- prompting a user of the device if the mechanism is to be granted RF access; see col. 13, line 61 – col. 14, line 5
- retrieving a user input regarding whether RF access should be granted to the mechanism requiring RF access; see col. 13, line 48 – col. 14, line 5
- if the user input indicates the mechanism is to be granted RF access, automatically enabling the RF device and allowing the mechanism requiring RF access to continue and access the RF device; see col. 13, line 34 – col. 14, line 5

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mauney [US 6,484,027] in view of Graham [EP 817 447 A1].

Regarding claims 6-8, Mauney as treated in claim 1 discloses all the limitations as claimed. However he is silent to teach a method wherein the electronic device comprises a hard button programmed to enable and disable the radio device by engaging the hard button for a pre-determined length of time, wherein the pre-determined length of time is less than one second.

Graham, in the same field of endeavor, teaches a method wherein the electronic device comprises a hard button programmed to enable and disable the radio device by engaging the hard button for a pre-determined length of time, wherein the pre-determined length of time is less than one second. See col. 3, line 46 – col. 4, line 23.

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teaching of Graham to Mauney in order to ensure that the electronic device is not inadvertently turned on/off.

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5. Claims 9,10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mauney [US 6,484,027] in view of Orimo [JP 407303134A].

Regarding claims 9,10, Mauney discloses a method wherein the software-enabled switch includes a user interface with a drop down menu having user options for radio on and radio off and programming configured to implement an option selected by the user. See col. 13, line 54 – col. 14, line 5. However Mauney does not disclose a method wherein the drop down menu includes an option for schedule and the application and system programs include a scheduling application that provides user modifiable start and stop times that indicate when the radio unit is to be enabled and disabled.

Orimo, in the same field of endeavor, teaches a method wherein the drop down menu includes an option for schedule and the application and system programs include a scheduling application that provides user modifiable start and stop times that indicate when the radio unit is to be enabled and disabled. See English translation of the document page 2, paragraphs 18-21.

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teaching of Graham to Mauney in order to ensure that the device is turned off in a restricted area (such as hospitals, theater, concert hall etc) and turned on once the user is outside the restricted area.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Palatsi [EP 817448A1]	User Interface
Wagner [US 6,282,435]	Graphical user interface for a portable telephone
Girard [US 2002/0132635]	Method of automatically selecting a communication mode in a mobile station having atleast two communication modes
Makela [US 6,047,196]	Communication device with two modes of operation
Finke-Anlauff [US 2003/0087663]	Soft keys for a mobile communication device having movable panels
Elomas [EP 1263199A2]	Mobile terminal and method of operation using context sensitive menu keys in a keypad locked mode
Sprigg [US 2002/0132645]	Mobile terminal with schedule display
Kraft [US 6,463,278]	Telephone automatic mode selection


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sujatha Sharma whose telephone number is 703-305-5298. The examiner can normally be reached on Mon-Fri 7.30am - 4.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sujatha Sharma  
May 11, 2004

  
NAY MAUNG  
**SUPERVISORY PATENT EXAMINER**